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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,791	08/28/2003	Marc D. Belcastro	021238-595	5604

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EXAMINER

MILLER, TAKISHA S

ART UNIT PAPER NUMBER

2855

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/649,791	Applicant(s) BELCASTRO ET AL.	
	Examiner Takisha Miller	Art Unit 2855	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10 and 13-16 rejected under 35 U.S.C. 102(b) as being anticipated by Bokelman et al. (5,966,218)(hereinafter Bokelman).

- a. With respect to claims 1,3-7,9,13 and 14, Bokelman teaches a method and system (2) for automatically inspecting a web of material at specific locations on said web of material during a manufacturing process comprising an unwind spindle (8,10) containing said web of material, a series of rollers (24,26-31) over which said web of material is guided, a rewind spindle (6,33) onto which said web of material is rewound, a testing device (14,16,18) for measuring a characteristic of said web of material at a location on said web of material between said unwind spindle (8,10) and said rewind spindle (6,33)(Col. 4, lines 36-57) and a printing device (20) that is adapted to print a sample code including information corresponding to a measured characteristic of a location on said web, said printing device (20) being positioned to print said sample code on said web at said location on said web (Col. 7, lines 50-65)(Fig.3).

- b. With respect to claims 2 and 8, Bokelman teaches a method and system further including collecting and evaluating finished cigarettes having at least one of said sample codes on said cigarette tipping paper (Col. 7, lines 62-65).

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- c. With respect to claim 10, Bokelman teaches a method and system further including determining test parameters before said measuring of a characteristic of said web of material, preparing a database file including information corresponding to said test parameters and incorporating said information corresponding to said test parameters on said sample code in addition to said information corresponding to said measured characteristic (Col. 10, lines 5-59).
- d. With respect to claim 15, Bokelman teaches a method and system wherein said testing device (14,16,18) measures a dimension of said web of material (Col. 7, lines 37-49).
- e. With respect to claim 16, Bokelman teaches a method and system wherein said testing device (14,16,18) visually inspects said web of material for out of specification conditions (Col. 7, lines 62-65).

Claim Rejections - 35 USC § 103

- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bokelman. Bokelman discloses measuring a characteristic of a web of material while the web is moving. The use of the particular type of process claimed by applicant, i.e., measuring the characteristic while the web is stationary, absent any criticality, is considered to be nothing more

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than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the web is measured for the same characteristic, as already suggested by Bokelman, 2) the measuring process claimed by Applicant and the measuring process used by Bokelman are well known alternate types of measuring processes which will perform the same function, if one is replaced with the other, and 3) the use of the particular type of measuring process used by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of measuring processes that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to effectively measure a characteristic of the web material as already suggested by Bokelman. Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to modify Bokelman to include the limitation above since that process is alternatively used in the art.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (4,059,120); (4,537,206); (4,121,595); (US2004/0129281); (4,112,154); (4,246,775); (4,403,619); (5,412,976) and (US2003/0087740) teach methods and apparatuses for testing paper.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Takisha Miller whose telephone number is (571) 272-2184. The examiner can normally be reached on Monday - Friday (7:00 am - 3:30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on (571) 272-2180. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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